

Serial No: 09/659,653

Attorney Docket No.: 1999-0541

REMARKS

Claims 1-9, 13 and 15-18 stand rejected under 35 USC 102 as being anticipated by Shiigi. The rejection is respectfully traversed.

Rejection Under §102 Improper

As a preliminary matter, applicants note that the rejection under 35 USC 102 is not proper. The theory under which the Office finds that the claimed invention is not patentable is based on a combination of two pieces of prior art—the Shiigi patent and the email capabilities of Hotmail. Applicant notes the following at p. 5 of the Office action:

The statement above [relative to the capabilities of Hotmail], combined with the material in the Shiigi reference, are the reasons the examiner stands by his rejection [emphasis added].

It is respectfully submitted that in order for a rejection to be proper under §102, the allegedly anticipating teachings must be found within the four corners of a single prior art document. Here, the Office action invokes two pieces of prior art in combination. Such a rejection is only properly made pursuant to 35 USC 103.

Moreover, it is submitted that because applicants' claims stand rejected based (in part) on a newly cited prior art teachings, the examiner is not standing by the prior rejection, as the Office action states but, rather, entering a new rejection.

The following remarks address the Office action as though the rejection had been made under §103 rather than §102.

Undated Reference to Hotmail is not Citable Prior Art

The Office action has not provided any date on which the cited Hotmail functionality was first known or used publicly. The rejection is therefore not proper, as it does not make out a prima facie case that that invention was known in, or render obvious by, the art prior to applicants' invention or filing date.

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The following remarks address the Office action based on the assumption—but only for purposes of discussion and without any admission—that the Hotmail functionality described in the Office action antedated applicants' invention.

The Shiigi/Hotmail Combination

Even if it were obvious to combine Shiigi with the Hotmail email capabilities noted in the Office action, and even if the Hotmail functionality preceded applicants' invention, the resulting combination is not the same as applicants' invention.

Moreover, the resulting combination does not anticipate applicants' claims.

Applicant agrees that when a Hotmail user opens up an email message that has an attached GIF file, the contents of the GIF file are automatically displayed below the typed message. Indeed, the undersigned replicated the Hotmail scenario set forth in the Office action by sending himself an email with a GIF attachment to a Hotmail account and then opening up the email using Hotmail. Attachment A shows the resulting Hotmail screen. The typed text is "This is a test." The GIF file was automatically opened by Hotmail and displayed below the text, the GIF file being an image of a handwritten signature of John Hancock.

This mode of operation of Hotmail does not anticipate applicants' claims, however. Applicants' claims state that the handwritten message image (e.g., a GIF file) and the typewritten message are transmitted in the same message field. More particularly, and in contrast to applicants' claimed invention, the only thing that the Hotmail program does is to open up the GIF attachment and display the file contents along with the text message. The actual transmission of the text and the image is in two separate message fields. This can clearly be seen from the fact that even though the GIF file is automatically opened and its contents displayed, the file still available for download as a separate entity. Note the displayed line "Attachment: handwriting.GIF" in Attachment A.

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The fact that the actual transmission of the text and the image is in two separate message fields can further be seen by enabling an option of Hotmail that allows one to see the full email header. (One does this by clicking on "Options/Mail Display Settings" and then clicking on the button labeled "Advanced" under the "Message Headers" heading.) When one does this for the sample email shown in Attachment A, what one sees is what is shown in Attachment B.

Specifically, what is then displayed are the MIME (Multipurpose Internet Mail Extensions) headers for this message associated with the various message fields themselves. One can clearly see from Attachment B that the GIF file called "handwriting" was sent to, and received by, Hotmail not in the same message field as the text, but in a separate message field.

In particular, the text message field is introduced with a first header "Content-Type: text/plain," followed by the text itself. By contrast, the image field is introduced with a second header "Content-Type: image/gif" followed by the name of the GIF file, i.e., name="handwriting.GIF." Clearly, then, the GIF file was not transmitted in the same message field as the text, but in a different field.

Further explanation of MIME can be found in Attachment C, which was downloaded by the undersigned from the following web page:

<http://www.mailsbroadcast.com/email.bolts&nuts/emailing.nutshell.htm>

Particular attention is directed to the following section, which begins at the bottom of the first page of Attachment C, specifically describing the automatic GIF-file-opening functionality pointed to in the Office action as being a feature of Hotmail:

(MIME) Multipurpose Internet Mail Extensions

MIME encoded messages consist of many parts--each part is allowed to be described in detail and some parts encoded. The purpose of MIME is to describe the many parts of an email message, such as attached sound files and images.

MIME messages may include a plain text message and a GIF image--because GIF image is binary data consisting of 8 bit characters. To get the GIF image data to pass through the Internet--Base 64 is used to encode the data into 6-bit characters.

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MIME is also used to annotate part of a message so that the receiving mail reader will know what data is stored in the message and process it optionally, i.e.; instead of listing the GIF file as a generic attachment--may automatically display it instead.

This excerpt points out, first of all, that the purpose of MIME is to “describe the many parts of an email message, such as attached sound files and images [emphasis added].” Thus it can be seen in Attachment B that the two MIME headers therein separately describe the text field of the message and the GIF attachment field of the message.

The fact that the GIF and text files are transmitted in separate message fields is further made clear from the statement in the quoted excerpt that GIF files sent as email attachments must be encoded in order to change their contents from 8-bit characters to 6-bit characters. There is no indication that the text portion of the message is encoded along with the GIF file so, necessarily, they are in different message fields. Indeed, Attachment B makes clear that base64 encoding was applied only to the GIF attachment, per the entry “Content-Transfer-Encoding: base64”

Moreover, the quoted excerpt points out that MIME annotates part of a message so that the receiving mail reader—in this case, the Hotmail program—will know what data is stored in the message and process it optionally. The quoted excerpt then gives the exact GIF example noted in the Office action wherein the mail reader “may automatically display” the GIF file. This makes clear that the GIF file is a separate entity in the message as transmitted so that the mail reader, e.g., the Hotmail program can, indeed, access the attached GIF file and “process it optionally.”

This is exactly what is going on in Hotmail. The GIF file arrives as a separately encoded file—not in the text message field. The mail reader, i.e., the Hotmail program, automatically opens the GIF file and its contents. Indeed, the contents of the GIF file are displayed in the same area of the screen that the text message is displayed. But, again, the GIF file was transmitted in its own message field, contrary to applicants’ claims.

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The examiner's attention is also respectfully directed to the fourth page of Attachment C which shows an example of a message with a GIF file attachment that follows the same format as applicants' Hotmail example of Attachment B.

In summary, then, although both the text message and GIF attachment may be displayed together in the same area of the Hotmail screen, the foregoing makes clear that this is merely a result of how the email reader—that is, the Hotmail program—has been configured to display those two fields. Nothing in any cited prior art shows or suggests that a typewritten reply message and a handwritten message image could or should be transmitted in the same message field.

In view of the foregoing, it is submitted that applicants' independent claims 1 and 15—and thus each of applicants' dependent claims as well—distinguish the invention from Shiigi. Reconsideration is requested.

Respectfully submitted,

Paul Henry Fuoss et al

By 

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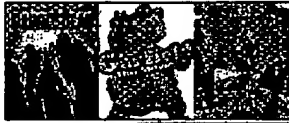
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Date: 10/15/2004

MSN Hotmail --Message

http://by18fd.bay18.hotmail.msn.com/cgi-bin/getmsg?msg=MSG10...

MSN Home | My MSN | Hotmail | Shopping | Money | People & Chat | Web Search:

Attachment A

**Rent new releases at Netflix**

- No Late Fees - ever!
- Over 25,000 Titles
- Free Shipping Both Ways

Try Netflix for FREE

Hotmail

Today | Mail | Calendar | Contacts

Options | Help

relby@usmail.com

Free Newsletters | MSN Featured Offers

Reply | Reply All | Forward | Delete | Junk | Put in Folder | Print View

Attachment: handwriting.GIF (< 0.01 MB)

This is a test.

John Hancock

Notice: Attachments are automatically scanned for viruses using McAfee

MSN Home | My MSN | Hotmail | Shopping | Money | People & Chat

Web Search:

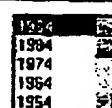
Attachment B

Rake in some old friends



I Graduated in:

classmates.com



Hotmail

Today

Mail

Calendar

Contacts

Options | Help

rdslusky@hotmail.com

Reply | Reply All | Forward | Delete | Junk | Put in Folder | Print View

Free Newsletters | MSN Featured Offers

From: ronald slusky <rdslusky@hotmail.com>
 Reply-To: rdslusky@verizon.net
 Sent: Thursday, October 14, 2004 4:58 PM
 To: rdslusky@hotmail.com
 Subject: Test

Inbox

Attachment: handwriting.GIF (< 0.01 MB)

MIME-Version: 1.0

X-Originating-IP: [68.161.197.127]

X-Originating-Email: [rdslusky@hotmail.com]

X-Sender: rdslusky@hotmail.com

Received: from 68.161.197.127 by b18fd.bay18.hotmail.msn.com with HTTP; Thu, 14 Oct 2004 20:58:58 GMT

View E-mail Message Source

Content-Type: multipart/mixed; boundary="-----_NextPart_000_2ef8_19b8_157b"

Content-Type: text/plain; format=flowed

This is a test.

Content-Type: image/gif; name="handwriting.GIF"

Content-Transfer-Encoding: base64

Content-Disposition: attachment; filename="handwriting.GIF"

John Hancock

Inbox

Notice: Attachments are automatically scanned for viruses using McAfee

Get the latest updates from MSN

MSN Home | My MSN | Hotmail | Search | Shopping | Money | People & Chat

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Feedback | Help

DELL Small Business

Today only!
\$300
 Savings!

Intel Inside
 pentium 4
 Prescott

\$649 \$349
 Desktop with
 17" CRT Monitor!

More Details

Expires 10/15/04 11:00 PM

Email messages are text files formatted to specifications outlined in RFC documents that describe how messages should be formatted and systems communicate with each other...

Emailing in a nutshell

[About Email Message Format](#)

[About Multipurpose Internet Mail Extensions](#)

[About binary data encoded message](#)

[About Email Message Structure](#)

[About Mail Servers Protocol](#)

[About Simple Mail Transfer Protocol](#)

[About Post Office Protocol](#)

[About Internet Message Access Protocol](#)

Email Message Format

A variety of data like; sound files, images and other binary information, etc., are included into email messages--which can be formatted by adding specific descriptions to all parts of the message.

For example; messages composed in "rich text" or HTML format may include WAV sound, GIF images attachment, etc.--the message will consist of 3 parts, so that a mail reader (MS Outlook or Eudora, etc.) can display the message in "rich text" or HTML with the image and play the sound WAV file--which are not included in normal email messages.

Hence, a standard format known as MIME (Multipurpose Internet Mail Extensions) has been created to describe the message parts and mail program conforming to this standard will be able to describe its own messages and interpret messages created by other systems.

(MIME) Multipurpose Internet Mail Extensions

MIME encoded messages consist of many parts--each part is allowed to be described in detail and some parts encoded. The purpose of MIME is to describe the many parts of an email message, such as attached sound files and images.

MIME messages may include a plain text message and a GIF image--because GIF image is binary data consisting of 8 bit characters. To get the GIF image data to pass through the Internet--Base 64 is used to encode the data into 6-bit characters.

"Attachment C"

eMail CRM
Broadcast
Freeware
[Click Here](#)

[Home](#)

<<back to>>

eMail
Bolts & Nuts

**SPAM
driving
you crazy?**

In a few minutes
time, you will have
the easiest & most
powerful way to
stop it... [Click here
for more info](#)



Auto-manage smtp
pop3 bounce email
[Click here
for more info?](#)

MIME is also used to annotate part of a message so that the receiving mail reader will know what data is stored in the message and process it optionally, i.e.; instead of listing the GIF file as a generic attachment--may automatically display it instead.

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Message Encoding Binary data

Message encoding binary data is often represented by 8 bit characters and some computers on the Internet are unable to transfer data represented by 8 bit characters. Therefore, the encoding process must convert 8 bit characters into smaller characters for sending across the Internet and then re-convert back to 8 bit characters by the receiving computer.

Base 64, UUencode and Quoted Printable are the most popular (there are several types of data encoding). Since many Internet email infrastructure was not designed to handle email messages containing binary information like file attachments--they are converted into a format that is compatible with computers on the Internet and this conversion process is called encoding.

Base 64 is generally used to encode binary attachments with MIME formatted messages and transforming 8 bit characters into 6 bit characters--which are compatible with the Internet infrastructure (will approximately increase data size to 130%) compared to the original.

UUencode (Unix to Unix) is an older form of data encoding that transforms 8 bit data into characters that are compatible with the Internet infrastructure. And most mail systems that support Base 64 are also backwards compatible with UUencode--which can only be understood by some older mail systems.

Quoted Printable encoding is suitable when small portions of the message data are stored into 8 bit characters, usually for text message that consists of characters less than 8 bits--normally for the message body text.

Quoted Printable encoding is designed to transform 8 bit characters into characters compatible with the Internet, similar to UUencode or Base 64 -- the difference is that "Quoted Printable" does not convert all the characters of the message, it only transforms characters which use more than 7 bits and any 8 bit characters are split into two or three smaller characters.

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RFC-822 Message Structure

Email messages are text files formatted to specifications outlined in **RFC 821** (Request For Comment) documents, that describes in detail how messages should be formatted and how systems should communicate with each other by following these guidelines.

An email message has the following parts: RFC-822 Message Header and Message Data

RFC-822 Message Header is the first part all email messages. It specifies the many options of the message and includes the subject line and headers are not required to be placed in any particular order. A MIME formatted message may contain many parts and each part may contain its own header and in the message data section.

Example of a Message Header:

Reply-To: "Service" <service@bouncemailmanager.com>
 From: "Tony" <service@bouncemailmanager.com>
 To: "Wendy" <support@mailsbroadcast.com>
 CC: "CEO" <ceo@mailsbroadcast.com>
 Subject: I am getting too many bounce mails.
 Date: Mon, 11 Nov 2002 12:38:23 -0400
 MIME-Version: 1.0
 Content-Type: text/plain; charset="iso-8859-1"
 Content-Transfer-Encoding: 7bit
 X-Priority: 1
 X-MSMail-Priority: Normal
 X-Mailer: Microsoft Outlook Express 6.00.2600.0000
 X-MimeOLE: Produced By Microsoft MimeOLE V6.00.2600.0000

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- Reply-To:** This is the specified email address that the sender wants the recipient to "Reply-To:" instead of the "From:" email address.
- From:** The "From:" email address in the header is allowed to be different from the email address that actually sent the message.
- To:** Message to be sent to that particular recipient.
- CC:** Send a carbon copy of the message to...
- Subject:** Message subject of the email.
- Date:** Indicates the date and time of the message created and a reference to the time zone used to calculate the date and time.
- MIME-Version:** Indicates the version used for MIME encoding of the message.
- Content-Type:** Header is only used with MIME messages—to declare the general type of data and the subtype specifies a format for that type of data. For example: Content-Type: of "text/plain"—inform the user agent that the data is in plain text format. The optional "charset" parameter tells the mail reader that the message is intended to be displayed with the "iso-8859-1" character set.
- Content-Transfer-Encoding:** Header is only used with MIME messages to specify an auxiliary encoding that was applied to the data, so that it is allowed to be to pass through the mail transport mechanisms—which may have data or character set limitations.
- Custom Headers (X-* Type):** Headers with an "X-" are added by the program that created the message and can be read by a mail reader, therefore, any special format specification or information contained in the message—can be taken advantage of—and ignored, if it is not recognized by a mail reader.
- X-Priority:** Custom header is quite popular but different mail readers may interpret it differently or not at all. For example: usually most mail readers set or interpret "4"=low "3"=normal and "1"=high

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Message Data following after the message headers is the "Message Data"--the composed message body text and any file attachment information. Below here is an example of a message body without files attachments:

I need further information about bounce mail manager,
please send it to service@mailsbroadcast.com
Thank you :)

--
TonyKoh
mailsbroadcast.com
<http://www.mailsbroadcast.com>
. <<<This period indicates the end of the message.

Example of a message with GIF file attachment encoded with MIME and "Quote Printable" message body (GIF encoded with Base 64) preceded by an attachment header, which preceded all attachments--describing various properties of the attachment.

This is a multi-part message in MIME format.
-----=_NextPart_000_0051_01BD9B7E.F01FEA90
Content-Type: text/plain;charset="iso-8859-1"
Content-Transfer-Encoding: quoted-printable
Message text.

--
TonyKoh
[BounceMailmanager.com](http://www.bouncemailmanager.com)
<http://www.bouncemailmanager.com>
-----=_NextPart_000_0051_01BD9B7E.F01FEA90
Content-Type: image/gif;name="welcome.gif"
Content-Transfer-Encoding: base64
Content-Disposition: attachment;filename="welcome.gif"
R0IBOCihAwALAKEVVN//// 6VVNUaGgFFFCH5BAEAA
AAALAAAAADAAsAAAYJhH6tauygkFSFACs=
-----=_NextPart_000_0083_01CF9B5S.B01ZWA70--
. <<<This period indicates the end of the message.

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Mail Servers Protocol

The most common protocols used by mail server to communicate with the Internet are SMTP, POP3 and IMAP4 to (send) receive email messages and distribute and them into different recipient unique mailbox.

Mail servers receive messages via SMTP and email readers must send email to a mail server using it. Mail servers using POP3 or IMAP4 to send messages, likewise; mail readers must use it to receive messages from the mail servers.

SMTP (Simple Mail Transport Protocol); for sending and receiving email messages and POP3 (Post Office Protocol Version 3); for delivering and retrieving email messages to mail readers, example: MS Outlook, Eudora, etc.

IMAP4 (Internet Message Access Protocol Version 4); for delivering messages to mail readers or to preview and retrieve emails from mail servers.

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(POP3) Post Office Protocol Version 3

POP3 is a standard client-server protocol for receiving emails. The POP3 mail servers listen for email requests via port 110 and send email to the requesting party. The client side (ie: Outlook, Eudora) mail readers can access (retrieve) emails by issuing a predefined set of commands to the mail server.

A POP3 session is created when a remote user connects to a mailbox on the POP3 mail server and ends when the remote user disconnects from it. While a session is open, no other user can retrieve email from the POP3 mailbox but email can still be sent to that account.

The POP3 clients (Outlook, Eudora) login to the POP3 server by sending as clear text the password for the mail account or uses APOP authentication--where the password itself is not sent to the remote mail server--using a digest created by the RSA MD5 algorithm--based on the password with a unique value sent by the POP3 mail server--that changes with connection. Therefore, APOP ensures that a different digest will be sent each time you log into the server.

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(IMAP4) Internet Message Access Protocol Version 4

IMAP4 is an alternative to POP3 for retrieving emails that operate via server port 143 that identify users by account name and password. IMAP4 protocol was designed to allow messages to be managed on the server. Since the messages remain on the server, the protocol is useful for users to access emails from various client computers.

IMAP4 server stores messages in different mailboxes. More than one user is allowed to access to an IMAP4 mailbox, therefore allowing mailboxes to be shared by multiple users.

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(SMTP) Simple Mail Transport Protocol

SMTP is a protocol governing electronic mail transmission and reception. A conversation is established with a SMTP server via port 25 --After the initial connection, the client ie: Eudora Mail, Outlook Express, etc. sends a HELO command followed by the domain name, telling the SMTP server whom it is talking to. The SMTP server may terminate the connection if it does not wish to speak to the specified domain.

If the **HELO** command is accepted by the remote server, the SMTP client issues a **MAIL-FROM** command followed by the **FROM:** address, at this point the SMTP server may terminate the connection if it does not wish to speak to the specified domain.

After the **FROM** address is accepted, the SMTP client issues a **RCPT-TO** command followed by the address of the intended recipient--the SMTP server may terminate the connection if it does not wish to speak to the specified address, example: non local.

The **SMTP** client issues the **DATA** command to the server and if accepted--it then send the message headers followed by blank line and the message body, file attachment and finally followed by a period to end the message--the SMTP server acknowledges receipt--and the SMTP client send a **QUIT** command and terminate the conversation.

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Extended SMTP

ESMTP consists of several extensions (all optional) to the basic SMTP protocol which may or may not be supported by mail servers. Whereas, normal SMTP involves several fragments of data being sent from the client to the mail server. After each fragment is sent, the client waits for the mail server acknowledgement reply and then the client sends the next fragment, and so on. Therefore, a time is wasted while waiting for the server to return a response.

Pipelining extension

Pipelining can send messages faster by allowing the client to batch several fragments of data together and sending them all at once, and the server only need to acknowledge with one reply for the combined set of data. Since the fragments and acknowledgements are combined, the client spends less time waiting for the server to respond.

Delivery Status Notifications

DSN extension supported SMTP servers allow greater control of the notification process by specifying when and how notifications are sent. DSN extensions also allow for an "Envelope ID" to be included in the outbound message, which is returned as a MIME part of the delivery status notifications--therefore, allowing client applications to match delivery status notifications to the original message.

An example MIME part to a DSN message with the Envelope ID specified as 3112394

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--FAA10845.816082428@mail.domain.com
Content-Type: message/delivery-status

Original-Envelope-Id: 3112394
Reporting-MTA: dns; mail.domain.com
Received-From-MTA: DNS; tony.bouncemailmanager.com
Arrival-Date: Tue, 10 Dec 2002 12:37:15 -0900 (EST)

Original-Recipient: rfc822:tony@bouncemailmanager.com
Final-Recipient: RFC822; xxx0021@mail.domain.com
Action: delivered (to mailbox)
Status: 2.1.5
Last-Attempt-Date: Tue, 10 Dec 2002 12:37:43 -0900 (EST)

-- FAA10845.816082428@mail.domain.com

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undeliverable bounced mails.
Freeware will not expire.
BounceMailmanager.com

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mass group broadcast Anti Spam Spamming abuse

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